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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/582,522   | 08/24/2000  | Zeev Maor            | 00654759            | 8228             |
| 26565  | 7590        | 12/14/2004           | EXAMINER            |                  |
| MAYER, BROWN, ROWE & MAW LLP<br>190 SOUTH LASALLE ST<br>CHICAGO, IL 60603-3441 |             |                      | YU, GINA C          |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 1617                |                  |

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/582,522

Applicant(s)

MAOR ET AL.

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,10,12,13,15-19 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5,15,18,19 and 21-24 is/are allowed.
- 6) ☒ Claim(s) 1,4,6,10,12,13 and 16 is/are rejected.
- 7) ☒ Claim(s) 3 and 17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 28, 2004 has been entered.

### ***Oath/Declaration***

Applicants' declaration filed on September 28, 2004 has been fully considered.

Indicated in the declaration is that the claimed clear gel may be formed by using various nonionic solubilizers, including ethoxylated sorbitan esters and PEG-hydrogenated castor oil for the hydrophobic component.

In distinguishing the present invention from the Dead Sea water composition of Kyotaro (JP 08113530), Declarant indicates that the prior art composition is used to cleanse the skin and removed, whereas the present invention is left on the skin upon application. Examiner respectfully points out that the intended use or purpose of the claimed subject matter does not render a patentable distinction.

Declarant also states that the Kyotaro composition forms "solid, coarse and inhomegeneous powder" and "white, non transparent slurry" upon the addition of a hydrophobic active agent (tocopherol acetate) and the subsequent dilution with water, respectively. Examiner respectfully points out that this comparison was not conducted

under the same condition with the present invention because nonionic solubilizers, which are required elements in the present invention, were not used in the experiments.

Nevertheless, the previous rejection made over Kyotaro in view of Biener (US 4943432) and Thompson (US 5425954), as indicated in the Office action dated April 7, 2004, is not maintained in view of the claim amendment. See Beiner, col. 1, line 42 – col. 2, line 9 (teaching way from using actual Dead Sea water).

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 4, 6, 10, 12, 13, and 16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6248340 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to a composition comprising Dead Sea water, at least one non-ionic solubilizer, a hydrophobic active agent, and gelling or viscosity modifier, and deionized water to make 100 wt %.

While the '340 patent claims a "liquid composition", claims 4 and 5 there teach to add a gelling agent which is defined in col. 4, lines 24 – 29. While the claims are silent as to the clarity of the composition, there is nothing in the '340 patent to indicate that the composition is opaque or cloudy. Non-ionic solubilizers (PEG 40 stearate, sorbitan tristearate) are taught in claim 10 of the patent. Emollients (cetyl alcohol) recited in claim 10 there also meet the hydrophobic active agents limitation in the instant claims. While the claims of the patent require algae extract, the specification defines that the algae contains tocopherol (a vitamin and an antioxidant) and glycerin (humectant). See instant claims 4, 6, 12, and 13. The hydrosoluble plant extract of the patent also meets the hydrophilic active agent limitation. See instant claims 10 and 13. Perfume is also taught in claim 10 of the patent. See instant claim 16.

While claim 8 of the patent teaches using 10-15 % of Dead Sea water, the specification defines Dead Sea water ingredient as a viscous, colorless and clear liquid. See instant claim 1, which requires 30-80 % of Dead Sea water. Examiner views that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the invention of '340 by increasing the amount of Dead Sea water, as motivated by the teachings therein, 1) to make a viscous gel and 2) to increase the beneficial effects of the active ingredients (i.e., minerals). The skilled artisan would have had a reasonable expectation of successfully making the gel because '340 teaches that Dead Sea water is viscous, clear, and colorless.

***Allowable Subject Matter***

Claims 5, 15, 18, 19, and 21-24 are allowed.

Claims 3 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

***Conclusion***

Claims 5, 15, 18, 19, and 21-24 are allowed.

Claims 1, 4, 6, 10, 12, 13, 16 are rejected under the judicially created doctrine of obviousness double patenting.

Claims 3 and 17 are objected to as depending upon a rejected base claim.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu  
Patent Examiner

SHENGJUN WANG  
PRIMARY EXAMINER